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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91188339
Party	Plaintiff RussellG.Weiner
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1	IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
2	Serial No. 77501585
3 4	Mark: DIVE BAR ROCK STAR
5)
6	RUSSELL G. WEINER, an individual,) Opposition No. 91188339
7	Opposer,)
8	v.)
9	EDWARD HOFRICHTER, an individual,) and JOHN PISANO, an individual,)
10	Applicants.)
11	
12	OPPOSER'S OPPOSITION
13	TO APPLICANTS' MOTION FOR JUDGMENT ON THE PLEADINGS
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15	Opposer Russell G. Weiner ("Opposer") hereby opposes the Motion for Judgment on the
16	Pleadings filed by Applicants Edward Hofrichter and John Pisano ("Applicants").
17	Opposer is confident that he will prevail in this opposition proceeding based on likelihood of
18	confusion between his well-known ROCKSTAR marks and Applicants' proposed DIVE BAR ROCK
19	STAR mark. Regardless, however, it would be improper to enter judgment in favor of Applicants at
20	this time. The parties have not served initial disclosures and have not taken any discovery – indeed, the
21	discovery period has not even opened yet. Applicants ask the Board to enter judgment based on the
22	pleadings alone, despite Opposers' well-pleaded allegations of priority and likelihood of confusion
23	concerning the similar marks at issue (and such allegations are presumed to be true at this stage in the
24	proceedings). This is not allowed under the law.
25	In short, Opposer's Notice of Opposition alleges facts that, if proved, are a sufficient basis for
26	refusing Applicants' registration. Therefore, the Board should deny Applicants' Motion for Judgment
27	on the Pleadings.
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STANDARD

For purposes of a motion for judgment on the pleadings, "all well-pleaded factual allegations of the nonmoving party must be accepted as true, while those allegations of the moving party which have been denied ... are deemed false." *Media Online v. El Clasificado, Inc.*, 2008 TTAB LEXIS 52, at *9-10 (TTAB 2008). Moreover, "[a]ll reasonable inferences from the pleadings are drawn in favor of the nonmoving party." *Id. See* TBMP § 504.02; *Baroid Drilling Fluids, Inc. v. Sun Drilling Products*, 24 USPQ2d 1048, 1992 TTAB LEXIS 6, at *4-5 (TTAB 1992) ("For purposes of the motion, all well-pleaded factual allegations of the nonmoving party are assumed to be true and the inferences drawn therefrom are to be viewed in a light most favorable to the nonmoving party.").

The Federal Circuit has recognized the "stringent" standard that applies to motions for judgment on the pleadings: "A motion for judgment on the pleadings should be denied unless it appears to a certainty that plaintiff is entitled to no relief under any state of facts which could be proved in support of his claim." *Mostowy v. United States*, 966 F.2d 668, 672 (Fed. Cir. 1992).

Accepting as true all facts alleged in Opposer's Notice of Opposition, a judgment in favor of Applicants would be patently inappropriate.

OPPOSITION

Opposer alleges in his Notice of Opposition likelihood of confusion between his various ROCKSTAR marks and Applicant's proposed DIVE BAR ROCK STAR mark. [Not. of Opp., ¶ 2 ("The mark shown in Serial No. 77501585 so resembles Opposer's marks as to be likely, when used on or in connection with the goods identified in Serial No. 77501585, to cause confusion, or to cause mistake, or to deceive.")] Opposer specifically cites six of his federally-registered marks. [Not. of Opp., ¶ 1] As stated in the Notice of Opposition, these registrations, as well as Opposer's common law rights in these marks, predate the filing of Applicant's application. [*Id.*] All such statements by Opposer are "accepted as true" for purposes of Applicant's Motion.

Priority and likelihood of confusion constitute one of the grounds for refusal of registration under the Lanham Act. 15 U.S.C. § 1052(d). *See* TBMP § 309.03(c)(1). Thus, as stated in the Notice

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1	of Opposition, Opposer will be damaged by registration of Applicant's proposed mark, and the Board
2	should refuse registration under Section 2(d).
3	Determining likelihood of confusion ultimately involves consideration of thirteen factors:
4	(1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
5 6	(2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
7	(3) The similarity or dissimilarity of established, likely-to-continue trade channels.
8	(4) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.
9	(5) The fame of the prior mark (sales, advertising, length of use).
10	(6) The number and nature of similar marks in use on similar goods.
11	(7) The nature and extent of any actual confusion.
12 13	(8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
14	(9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).
15	(10) The market interface between applicant and the owner of a prior mark:
16	(a) a mere "consent" to register or use.
17 18	(b) agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party.
19	(c) assignment of mark, application, registration and good will of the related business.
20	(d) laches and estoppel attributable to owner of prior mark and indicative of lack of
21	confusion.
22	(11) The extent to which applicant has a right to exclude others from use of its mark on its goods.
23	(12) The extent of potential confusion, i.e., whether de minimis or substantial.
24	(13) Any other established fact probative of the effect of use.
25	
26	In re E. I. Du Pont de Nemours & Co., 476 F.2d 1357, 1361 (CCPA 1973). See TBMP §
27	309.03(c)(B) ("The evidentiary factors the Board considers in determining likelihood of confusion
28	-3-

are set out in [Du Pont]. ... The relevance and weight to be given the various factors may differ from case to case.").

Clearly the Board cannot properly analyze all (if any) of the above *Du Pont* factors based only on the allegations in the pleadings.

Insofar as the pleadings shed light on a few of the *Du Pont* factors, these factors appear to support a finding of likelihood of confusion. For example, the marks at issue – Opposer's ROCKSTAR and ROCKSTAR composite marks on the one hand, and Applicant's proposed DIVE BAR ROCK STAR mark on the other – contain the same dominant elements, and are substantially similar. Furthermore, the goods identified in Applicants' application, which include beverage glassware, mugs, and coasters, are related to Opposer's goods. That being said, the pleadings simply do not address many key *Du Pont* factors, such as the relevant purchasers and the fame of the prior mark, which weigh strongly in favor of Opposer. *See Recot, Inc. v. Becton*, 214 F.3d 1322, 1327 (Fed. Cir. 2000) ("The fifth *DuPont* factor, fame of the prior mark, when present, plays a 'dominant' role in the process of balancing the *DuPont* factors.").¹

Applicants do not cite any cases in which the Board granted a motion for judgment on the pleadings in the face of an opposer's well-pleaded allegations of priority and likelihood of confusion. Indeed, where an applicant is so brazen as to file a motion for judgment on the pleadings under these circumstances, the Board routinely denies such a motion. *See*, *e.g.*, *T.M. Pacific Co.*, *Ltd. v. The Body Shop International*, *PLC*, 1998 TTAB LEXIS 431, at *6-7 (TTAB 1998); *Chatam International Inc. v. Abita Brewing Company*, *Inc.*, 49 USPQ2d 2021, 1998 TTAB LEXIS 527, at *6 (TTAB 1998); *Creo Products Inc. v. Martin-Williams*, *Inc.*, 2002 TTAB LEXIS 560, at *6-7 (TTAB 2002) (non-precedential) (rejecting opposer's argument that "a single factor can outweigh all others and be dispositive of the issue of likelihood of confusion" for purposes of a motion for judgment on the pleadings).

¹ Opposer's ROCKSTAR energy drinks are among the most popular in the world. Opposer's licensees have sold over one billion cans of product and annually have sales of several hundred million dollars.

1	Applicants' reliance on <i>In re Coca-Cola</i> , Serial No. 78449413 (Oct. 29, 2006) – an <i>ex parte</i>
2	appeal - reflects Applicants' misunderstanding of the applicable standard. In fact, after the Board's
3	ruling in Coca-Cola, applicant's proposed mark SPRITE QUENCH was published for opposition, and
4	the owner of the registered mark QUENCH opposed. That opposition proceeding (Opp. No.
5	91185243) is currently pending. ²
6	CONCLUSION
7	Applicants seek to end this proceeding before it truly begins. For the reasons discussed above,
8	the Board should deny Applicants' Motion for Judgment on the Pleadings and allow Opposer to wage
9	its opposition.
10	Dated: March 17, 2009 Respectfully submitted,
11	HARVEY SISKIND LLP
12	/s/
13	By: Seth I. Appel
14	Four Embarcadero Center, 39 th Floor
15	San Francisco, CA 94111 Telephone: (415) 354-0100
16	Facsimile: (415) 391-7124
17	Attorneys for Opposer Russell G. Weiner
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23	² In any event, the Board's analysis in <i>Coca-Cola</i> supports a finding of likelihood of confusion here.
24	The Board explained: "Generally, when a mark of one party completely encompasses that of another on related or identical goods there will be likelihood of confusion, particularly where the matter
25	added to one of the marks is descriptive or highly suggestive." Here, the only meaningful difference between the parties' marks is Applicant's inclusion of the term "DIVE BAR," which Applicant
26	concedes "refers to and specifically connotes" an aspect of Applicant's products. (In Coca-Cola, the Board's decision to allow applicant's SPRITE QUENCH mark to be published for opposition turned
27	largely on the inclusion of the "arbitrary mark" SPRITE.)

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1	CERTIFICATION OF TRANSMISSION
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3	I hereby certify that a true and correct copy of the attached OPPOSER'S OPPOSITION TO APPLICANTS' MOTION FOR JUDGMENT ON THE PLEADINGS, dated March 17, 2009
4	(Opposition No. 91188339), is being electronically transmitted to the Trademark Trial and Appeal Board on March 17, 2009.
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6	/s/
7	Seth I. Appel
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1	CERTIFICATE OF SERVICE
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3	I hereby certify that a true and correct copy of the attached OPPOSER'S OPPOSITION TO APPLICANTS' MOTION FOR JUDGMENT ON THE PLEADINGS (Opposition No. 91188339),
4	was served on Applicants by depositing a copy thereof with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to Mark Lebow, Young & Thompson,
5	209 Madison Street, Suite 500, Alexandria, VA 22314, on March 17, 2009.
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7	Seth I. Appel
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